

**REMARKS:**

**Status Of Claims**

Claims 1-20 were previously pending, with claims 1, 17, and 20 being independence. Claims 1, 12, 17, and 20 are currently amended. Thus, claims 1-20 are currently pending in the application with claims 1, 17, and 20 being independent.

**Office Action**

In the office action, the Examiner rejected claims 1-8, 11, 17, and 18 under 35 U.S.C. 103(a) as being unpatentable over an article written by Maier in view of an article written by Campos, and further in view of an article written by Stockweather. The Examiner also rejected claims 9, 10, 12-16, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over an article written by Maier in view of an article written by Campos, further in view of an article written by Stockweather, and in further view of Colgan, U.S. Patent No. 5,510,978. Applicant respectfully asserts that the currently pending claims distinguish the present invention from the prior art references of record.

**Amendments**

Specifically, claim 1 now recites the step of "prompting the witness to identify other witnesses, wherein a central computer attempts to contact the other witnesses via a communications network to request further information about an incident". This is supported in the specification beginning on page 4 line 30 to page 5 line 3 and further distinguishes claim 1 over the prior art. Additionally, claim 12 has been amended to also recite the step of "providing a warning system that alerts users to certain dangerous conditions based on incident reports". This is supported in the specification on page 9 lines 3-9.

### **Legal Discussion of Obviousness**

In rejecting claims under § 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). The Examiner has the initial burden of presenting a *prima facie* case of unpatentability, whether based on prior art or any other ground. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "If the PTO fails to meet this burden, then the applicant is entitled to the patent." *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002). If the Examiner satisfies the burden of establishing a *prima facie* case of obviousness, the burden shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. *In re Kumar*, 418 F.3d 1361, 1366 (Fed. Cir. 2005). "When rebuttal evidence is provided, the *prima facie* case dissolves, and the decision is made on the entirety of the evidence." *Id.*

In *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, 2007 WL 1237837, 82 USPQ2d 1385 (S. Ct. April 30, 2007), the Supreme Court reaffirmed that the *Graham* factors continue to define the inquiry controlling the obviousness determination. *KSR*, 2007 WL 1237837 at \*7. The four *Graham* factors are (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating secondary consideration evidence, such as commercial success, long felt but unsolved needs, failure of others, etc. *Graham*, 383 U.S. at 17-18.

Deputy Commissioner Focarino noted the reaffirmation of *Graham* and set forth other principles that govern the PTO's obviousness determination following *KSR* in her May 3, 2007, Memorandum to the Technology Center Directors ("Focarino Memorandum") for the present time. These are the principles that must now be met in order for an Examiner to establish a *prima facie* case of obviousness.

Inventions generally rely upon previously known "building blocks" and will of necessity be combinations of what is already known. *KSR*, 2007 WL 1237837 at \*14. Thus, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements, was, independently, known in the prior art." *Id.*

Under *KSR*, in order to establish a *prima facie* case of obviousness based upon a combination of prior art elements, an Examiner must identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the claimed manner. *KSR*, 2007 WL 1237837 at \*14; Focarino Memo at 2. **Mere conclusory statements cannot sustain an obviousness rejection; there must be "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."** *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 2007 WL 1237837 at \*13.

Taking into account the interrelated teachings of the prior art references; the effects of the demands known to the design community or marketplace; and the background knowledge possessed by a person having ordinary skill in the art, the Examiner should determine "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." *KSR*, 2007 WL 1237837 at \*13; Focarino Memo at 2.

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

Focarino Memo at 2.

*KSR* did not alter the requirement that in order to establish a *prima facie* case of obviousness, the prior art references when combined must teach or

suggest all the claim limitations. *KSR*, 2007 WL 1237837 at \*14 (addressing obviousness based on all elements of claim); *In re Royka*, 490 F.3d 981, 985 (CCPA 1974) (obviousness rejection reversed where references taken all together were still missing essential limitation of claimed invention); *Ex parte Kalliokulju*, 2007 WL 1378833 at \*3 (Bd. Pat. App. & Interf. May 10, 2007) (Not Written for Publication) ("Because we find the combination of Chen and Maggenti fails to teach or suggest all the limitations recited in the claim, we agree with Appellants that the Examiner has failed to meet the burden of presenting a *prima facie* case of obviousness."); MPEP § 2143.03.

Moreover, all words in the claim must be given effect in assessing the patentability of the invention over the prior art. MPEP § 2143.03; *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art."); *Ex parte Petersen*, 228 USPQ 216, 217 (Bd. Pat. App. 1985) ("It is axiomatic that not only must claims be given their broadest reasonable interpretation consistent with the specification but also all limitations must be considered."); *Ex parte Scarpa*, 2003 WL 25283769 at \*3 (Bd. Pat. App. & Interf. Feb. 10, 2003) (Not Written for Publication) ("When evaluating claims for obviousness under § 103(a), all of the limitations recited therein must be considered and given weight, even those which do not find support in the specification as originally filed. See MPEP § 2143.03.")

### **Arguments**

The Examiner has failed, with regard to the rejections of claims 1, 17, and 20 under 35 U.S.C. § 103(a) over Maier in view of Campos and in view of Stockweather, to establish the requisite *prima facie* case of obviousness by citing a combination of references that teaches or suggests the claim limitation selecting an authority to whom the incident report should be sent, wherein the authority is

selected based at least in part on information provided by the witness and wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness.

Specifically, Stockweather discloses a system that will supposedly "dispatch vehicles to the scene of a police, fire or emergency services incident". However, at no point does Stockweather actually explain how dispatching decisions are made. For example, Stockweather discloses a "computer system dispatch monitor [that] shows a map of the city that automatically locates all emergency vehicles. The computer identifies instantly the vehicles closest to the incident and their status. Dispatch instructions are transmitted to ... the dispatched vehicles telling the drivers the exact location, the level of priority and what type of incident requires their response." Thus, Stockweather discloses a system that tracks vehicles and can send dispatch instructions to those vehicles closest to the incident, but does not disclose any method of selecting an appropriate authority, or deciding whether to dispatch police, fire or emergency services.

Therefore, one possible reading of Stockweather suggests a system that does not actually select an authority, as defined in the specification and used in the claims, but rather simply identifies the closest vehicles and dispatches those vehicles to the scene, without regard to whether the incident actually requires police, fire, or emergency services. Presumably, the individuals receiving those dispatch instructions would be able to decide whether they were needed. For example, a fireman receiving a report about a stolen car would be able to decide that the appropriate authority was the police and that he did not need to respond. However, in this reading, the individuals receiving those dispatch instructions are actually selecting the appropriate authority, rather than "the authority [being] automatically selected by the computer system", as claimed in claim 1. Such a system would be very crude, waste valuable time, and cause infinite uncertainty, as each vehicle would have to receive each report concerning their vicinity and then decide for

themselves whether or not they should respond. Such a system would certainly result in a giant leap backwards in public safety. As nobody could be sure who was actually responding to each report, such a system could not "greatly [increase] the responsiveness of police, fire and ambulance services", as is Stockweather's disclosed intended purpose. Thus, this reading of Stockweather would render it "unsatisfactory for its intended purpose", and therefore combining this reading of Stockweather with Campos and Maier would be improper.

Reading a bit more refinement into Stockweather is more reasonable. For example, Stockweather discloses that the system "includes ... dispatching workstations [and] dispatcher interface software". Therefore, Stockweather's system must include dispatchers to operate the "dispatching workstations" using the "dispatcher interface software". Again, as Stockweather does not disclose the computer system itself deciding between police, fire, or emergency services, Stockweather's dispatchers must make these decisions. In fact, this is the only reading that is consistent with the entire article, because if Stockweather's system could make these decisions, there would be no need of the "dispatching workstations [and] dispatcher interface software".

The Examiner has failed, with regard to the rejections of claims 5 and 6 under 35 U.S.C. § 103(a) over Maier in view of Campos, to establish the requisite *prima facie* case of obviousness by citing a combination of references that teaches or suggests the claim limitations of (1) the additional information being obtained by searching files accessible by the computer system based on the identification information entered by the witness and (2) the additional information being obtained by receiving the additional information from the authority based on the information entered by the witness.

The Examiner has further failed to establish a *prima facie* case of obviousness with respect to claims 5 and 6 because each of those claims includes

additional limitations that are not taught or suggested by the prior art. For example, the prior art references of record do not teach or suggest the step of "receiving additional identification information identifying the offender and adding the additional identification information to the incident report" (as claimed in intermediate claim 4), wherein the additional information is obtained by "searching files accessible by the computer system based on the identification information entered by the witness" (as claimed in claim 5) or "receiving the additional information from the authority based on the information entered by the witness" (as claimed in claim 6).

The Examiner concedes that neither Campos nor Maier discloses the limitations of claims 5 and 6, but argues that:

it is well known in the art to receive additional information about the offender by searching the computer system or receiving from the authority. For example, a police officer can obtain more information about the offender by searching the computer database or receives from the other resource such as individuals, groups of influence in the community organizations, etc. . . . Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature above in Maier modified by Campos for the purpose of providing more information about the offender in order to quickly solve ongoing crimes. (Office Action dated September 11, 2007, page 5).

Appellant respectfully disagrees. The computer-based method of claims 5 and 6 does not simply "receive additional information about the offender," but, among other things, receives an incident report "directly from a witness" and adds additional information to the report "identifying the offender," wherein the additional information is gathered by searching files or is received from the authority. Therefore, the computer system supplements information received directly from the witness with additional information about the offender and automatically selects an authority based on the information supplied by the witness. This combination is clearly not taught or suggested by the prior art references of record, nor is it well known in the art.

The Examiner has further failed to establish a *prima facie* case of obviousness with respect to claims 7 and 8 because each of those claims includes additional limitations that are not taught or suggested by the prior art. For example, the prior art does not teach or suggest the steps of selecting a particular agency, as recited in claim 7, or an agency rather than an individual, as recited in claim 8.

Again, the Examiner concedes that neither Campos nor Maier disclose the limitations of claims 7 and 8, but argues that

transmitting an incident report depends on the type and how serious of the incident to the selected agency from different agencies such as a local police department, a local prosecutor's office, the Federal Bureau of Investigation, the Central Intelligence Agency, a government agency, is well known in the art of handling the crime incidents in the United States of America. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above in Maier modified by Campos for the purpose of providing more efficiency in solving ongoing crimes. (Office Action of September 11, 2007, page 6).

Appellant respectfully disagrees. The claimed invention involves a computer-based method including the step of "selecting an authority . . . wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness." Therefore, even assuming that "transmitting an incident report depends on the type and how serious of the incident . . . is well known" as the Examiner asserts, it certainly is not well known to automatically select such an authority based on a report entered directly by a witness. The latter step involves, among other things, programming a computer to both determine the appropriate authority based on the report, and automatically sending the report to that authority.

Furthermore, even assuming that Campos does disclose a computer that automatically selects an officer or vehicle from a group of officers or vehicles (as the Examiner argues), that is quite a different proposition than selecting an authority. The system disclosed in Campos clearly relies on human input (from the



call-taker and the dispatcher) to determine the type of call (police, fire or medical) and to "decide what type of response is appropriate for the incident." The inventions of claims 7 and 8 are much more robust in that they automatically select an authority, not just a particular officer or vehicle, to whom the incident report must be sent.

The Examiner has further failed to establish a *prima facie* case of obviousness with respect to claims 15 and 16 because each of those claims includes additional limitations that are not taught or suggested by the prior art.

The Examiner again concedes that none of the prior art references of record disclose the limitations of claims 15 and 16, but argues that

contacting the witness to receiving more information about the offender is well known, moreover, conventional electronic message allows people to send and receive messages over the computer network. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Maier modified by Campos and Colgan for the purpose of allowing the witness to receive and update information in order to assist the authority to solve crimes. (Office Action dated September 11, 2007, pages 7-8).

Appellant respectfully disagrees. Even assuming that the broad concept of contacting a witness to receive additional information is well known, the invention of claims 15 and 16 comprises several elements the combination of which most certainly is not well known in the art. The computer-based method of the invention of claims 15 and 16 involves the steps of, among other things, receiving into a computer system an incident report directly from a witness, automatically selecting an authority to which the report is sent, permitting persons to view all incident reports, receiving additional information from the persons, and sending the additional information to the witness.

It should be noted that these steps are implemented as part of a single computer-based method, therefore, such steps are not only integrated into a single

process, but are implemented by a computer and therefore are performed automatically. This clearly presents a distinct advance in the art which, according to the Examiner's assertion, relied in the past on "conventional electronic messages" such as e-mail.

Amendments to claims 1, 12, 17, and 20 further differentiate these claims from the prior art. The remaining claims all depend directly or indirectly from independent claim 1 and 17 are therefore also allowable. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,  
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